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#18 W. Lowager 6/25/01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Toshiaki Kojima	)	
Serial No.:	08/909,023	)	
Title:	RECORDING, REPRODUCING, AND RECORDING/REPRODUCING APPARATUSES AND METHODS THEREOF	)	Examiner: C. Onuaku Group Art Unit: 2715
Filing Date:	August 11, 1997	)	
Case No.:	112857-108	)	

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Assistant Commissioner for Patents
Washington, DC 20231

RESPONSE TO OFFICE ACTION

The present remarks are in response to the non-final Office Action entered in the above identified patent application and mailed on March 13, 2001. Claims 1-32 remain pending in the application. All of the pending claims stand rejected under 35 U.S.C. §103. Claims 1 and 3-6 were rejected over U.S. Patent No. 5,940,241 to Sasakura in view of U.S. Patent No. 6,128,148 to Platte et al. Claims 2, 7, 9-14, 16-21, and 23-28 were rejected over Sasakura and Platte et al. further in view of U.S. Patent No. 5,532,830 to Schuler. Claim 8 was rejected over Sasakura and Platte further in view of U.S. Patent No. 5,949,953 to Sasakura et al. Finally, claims 15, 22, 30, 31, and 32 were rejected over Sasakura, Platte et al., and Schuler further in view of Sasakura et al. Applicant respectfully traverses.

6/20/07 VG

The claims of the present application are not obvious in light of the prior art for at least two reasons. First, there is no teaching or suggestion within the Sasakura and Platte references that would have led one of ordinary skill in the art to make the combination suggested by the Examiner. Second, even if one of ordinary skill in the art would have been motivated to make

the combination suggested by the examiner, the combination does not teach or suggest the invention as claimed in the present application.

Turning first to the lack of suggestion to combine the references, Applicant notes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, In re Fine, 837, F2d 1071, USPQ2d 15965 (Fed. Cir. 1988). In the present case there is no such teaching or suggestion found within the references that would have led one of ordinary skill in the art to combine the features of the magnetic tape cassette disclosed by Platte et al. with the magnetic disc system disclosed by Sasakura. First, it is noted that the magnetic tape device of Platte et al. is a linear device. Data can be accessed from the magnetic tape only by allowing the tape to continuously traverse a magnetic head. The tape forms a memory including several bytes of information at the beginning of the tape and arranged linearly thereon. The first several bytes include data regarding the contents of the tape and various allowed modes of operation. The data may include overwrite protection wherein overwriting certain portions of the tape is prohibited. The recording device compares the current position of the tape with position entries stored in the memory defining tape positions on which overwriting is prohibited. Only when this comparison indicates that no overwriting is possible is the record function released.

The data storage device disclosed by Sasakura, on the other hand, is a rotating disc device. Data can be accessed from the disc without regard to the position of a continuous tape. Thus, an overwrite protection scheme which relies on a comparison between a tape position stored on the tape itself and the actual linear position of the tape would not be applicable to the

image signal recording system for recording an image signal on a recording medium disclosed by Sasakura. Platte et al. do not teach that there recording protection system for magnetic tape cassettes could be applied to rotating disc systems, nor does Sasakura suggest that an overwriting protection system based on the position of a magnetic tape would be beneficial to a rotating disc system. Absent a such teaching or suggestion to combine within the references themselves there would have been no motivation for one of ordinary skill in the art to combine the Sasakura and Platte et al. references as suggested by the Examiner to arrive at Applicant's invention.

Furthermore, even if one of ordinary skill in the art would have been motivated to make the combination suggested by the examiner, the combination does not teach or suggest the invention as claimed in the present application. There are presently four independent claims pending in the instant application, namely, claims 1, 9, 16, and 23. Each of these claims calls for, among other things, either a control means for, or a step of, controlling a recording means so as to endlessly record and overwrite a portion of said first data while avoiding or excluding a recording region of the recording medium in which said second data has been recorded, wherein the second data is a portion of the first data or has already been recorded in the recording medium. Neither Sasakura nor Platte et al. (nor Schuler or Sasakura et al., for that matter) teach or suggest endlessly recording and overwriting a portion of first data while avoiding or excluding another portion of the first data.

Sasukura merely teaches an extended track mode of operation for storing image data on a disc, wherein data can be recorded onto a magnetic disc having up to 50 tracks. During an initialization process the system determines which tracks have already been written to so that future image data to be recorded can be written to the unoccupied tracks. However, Sasakura

makes no mention of endlessly recording over some tracks which have been previously written to while avoiding others. The Examiner points to column 4, line 46 to column 5, line 63 as teaching this feature, but this simply is not an accurate reading of Sasakura. The passage cited by the Examiner is the written description of the flowchart of Fig. 2. It must be noted that at each of steps ST7, ST8, ST9, and ST10, Sasakura describes moving the magnetic head to an unrecorded track. Sasakura does not teach or even suggest endlessly overwriting portions of prerecorded data. Thus, even if one of ordinary skill in the art were motivated to include the overwrite protection system disclosed by Platte et al. (an unlikely event given the fact that Sasakura always moves to an unrecorded track) the resulting combination does not teach endlessly overwriting portions of the prerecorded data. Since the cited combination does not teach or suggest the invention as claimed, the rejection under 35 U.S.C. §103 is improper and should be withdrawn.

With regard to the dependent claims and the remaining references, Schuler and Sasakura et al. are cited for disclosing elements of the claims other than those described above which are not taught or suggested by the primary references, namely Sasakura and Platte et al. Since the dependent claims include all of the features of the base claims, it follows that since the dependent claim are allowable, the dependent claims should be allowed as well.

In light of the above remarks, Applicant respectfully submits that all of the pending claims are now in condition for allowance and request that the Examiner allow the application to issue. However, if there are any remaining issues the Examiner is encourage to call Applicant's attorney, Jeffrey H. Canfield at (312) 807-4233 in order to facilitate a speedy disposition of the present case.

If any additional fees are required in connection with this response they may be charged to deposit account no. 02-1818.

Respectfully Submitted,

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